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✓ 123

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/405,088 09/27/99 USKELA

S 017.37498X00

020457 QM12/0709  
ANTONELLI TERRY STOUT AND KRAUS  
SUITE 1800  
1300 NORTH SEVENTEENTH STREET  
ARLINGTON VA 22209

EXAMINER

NGUYEN, B

ART UNIT

PAPER NUMBER

3713

DATE MAILED:

07/09/01

9

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

<p align="center"><b>Office Action Summary</b></p>	<p>Application No.</p> <p>09/405,088</p>	<p>Applicant(s)</p> <p>USKELA ET AL.</p>	
	<p>Examiner</p> <p>Binh-An D. Nguyen</p>	<p>Art Unit</p> <p>3713</p>	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

- |                                                                                               |                                                                              |
|-----------------------------------------------------------------------------------------------|------------------------------------------------------------------------------|
| 15) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 17) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 20) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

1. The Amendment filed in Paper No. 8, April 10, 2001 has been received.

According to the amendment, claims 1-11 have been canceled and new claims 12-31 have been added. Acknowledgment has been made.

2. Claim 22 is objected to because of the following informalities:

In claim 22, the recited terms "wiht" (line 1) must be changed to "with"

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 12-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 12, 15, and 25 the recited term "the game sponsoring gateway controls" lines 13, 12, and 6, respectively, lacks antecedent basis.

In claims 13 and 14, the recited phrase "the mobile terminal" (line 7 and 5, respectively) lacks antecedent basis.

Claim 21 is vague and indefinite because its scope is unclear.

Claim 29 is vague and indefinite because it depends on itself. Note that, it seems to be dependant of claim 25.

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5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claims 12, 14, 15, 17, 20-25, 28, 29, and 31, as best understood, are rejected under 35 U.S.C. 102(e) as being anticipated by James et al. (5,964,660).

James et al. teach a system and method for sponsoring games network comprising a communications network (14); a game sponsor gateway in communication with communications network (5:12-17); a user terminal (12) in communication with the communications network to access game sponsoring gateway; a game server in communication with game sponsor gateway to supply games over communications network to user terminal; a sponsor content server in communication with game sponsoring gateway to supply advertising over the communications network to user terminal; a user data server 10 (7:1-10); means for supplying games to game sponsor gateway for delivery over the communications network to user terminal; means for selecting user specific advertising and inserting advertising into the game supplied to user terminal (10:17-20); accessing game sponsoring gateway through a communications network; accessing a game from a game provider through game sponsoring gateway; selecting advertising for a specific user; and supplying advertising to the user; and user selecting advertising for display in games supplied to him over the communications network (5:45-64). See also Figures 1-2 and columns 1-10.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 12-31, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over James et al. (5,964,660) in view of Merriman et al. (5,948,061) or Hanson et al. (5,947,398).

James et al. teach a system and method for sponsoring games network comprising a communications network (14); a game sponsor gateway in communication with communications network (5:12-17); a user terminal (12) in communication with the communications network to access game sponsoring gateway; a game server in communication with game sponsor gateway to supply games over communications network to user terminal; a sponsor content server in communication with game sponsoring gateway to supply advertising over the communications network to user terminal; a user data server 10 (7:1-10); means for supplying games to game sponsor gateway for delivery over the communications network to user terminal; means for selecting user specific advertising and inserting advertising into the game supplied to user terminal (10:17-20); accessing game sponsoring gateway through a communications network; accessing a game from a game provider through game sponsoring gateway; selecting advertising for a specific user; and supplying advertising to the user; and user selecting advertising for display in games supplied to him over the

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communications network (5:45-64). See also Figures 1-2 and columns 1-10. James et al. do not explicitly teach means for profiling data of user accessing games through user terminal, and supplying profiled data to sponsoring gateway to select advertising for display in games provided to a user terminal; means for determining the location of a user accessing games through a user terminal and supplying the location to the game sponsoring gateway for selecting geographic sensitive advertising for display in games provided to a user terminal; determining user specific profiles for selecting the advertising; determining user's geographic location and inserting the advertising into the game for display to user; game gateway selecting the advertising supplied to the user in games supplied over the network based upon a criteria from a historical database.

Merriman et al. or Hanson et al., however, teach means for profiling data of user accessing games through user terminal, and supplying profiled data to sponsoring gateway to select advertising for display in games provided to a user terminal; means for determining the location of a user accessing games through a user terminal and supplying the location to the game sponsoring gateway for selecting geographic sensitive advertising for display in games provided to a user terminal; determining user specific profiles for selecting the advertising; determining user's geographic location and inserting the advertising into the game for display to user; game gateway selecting the advertising supplied to the user in games supplied over the network based upon a criteria from a historical database. See Merriman et al.'s Figures 1-3c and columns 2-8; or Hanson et al.'s Figures 1-3, 6-15, and columns 1-10.

Regarding the limitation of a location server communicating with game sponsor gateway, it is very well known in the global communications network for an affiliate website server to know the location of a requesting source (users or net-surfer's location) by the address of its service provider server.

Thus, it would have been obvious to a person of ordinary skill in the art at the time of the invention to combine James et al.'s network gaming with method and system for delivering advertisement of Merriman et al. or Hanson et al. to come up with a system and method for sponsoring games network.

9. Applicant's arguments with respect to claims 12-31 have been considered but are moot in view of the new ground(s) of rejection.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh-An D Nguyen whose telephone number is 703-305-5713. The examiner can normally be reached on Mon-Fri.

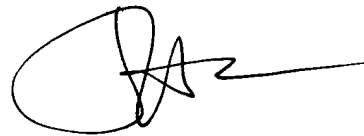
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 703-308-4119. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3580 for regular communications and 703-308-7768 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

Binh-An D Nguyen  
Examiner  
Art Unit 3713



BN  
June 29, 2001



JESSICA J. HARRISON  
PRIMARY EXAMINER